

REMARKS

Claims 8-10, 24-26, 28-30, 33-36 and 38-47 were pending in the present application. In order to facilitate claim numbering, all of the pending claims have been canceled, without prejudice, and the claims have been re-written as claims 48-69. Accordingly, claims 48-69 will be pending upon entry of the instant amendment. Any cancellation of the claims should in no way be construed as an acquiescence to any of the Examiner's rejections and was done solely to expedite prosecution of the application. No new matter has been added, and Applicants submit that all of the claims are now in condition for allowance.

The Rejection of Claims 8, 10, 28, 30, 33, 34 and 47 under 35 U.S.C. §112, First Paragraph, Should Be Withdrawn

Claims 8 and 30 and the dependent claims 10, 28, 33, 34 and 47 are rejected under 35 U.S.C. §112, first paragraph, as “[c]ontaining subject matter which was not described in the specification in such a way as to reasonably convey to one of skill in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.” Specifically, the Examiner states that the claims introduce new matter by introducing the term “over the length of said nucleic acid molecule”.

In the interest of expediting prosecution, and without acquiescing to the Examiner's rejection, Applicants have re-written the new claims to remove any reference to the term “over the length of said nucleic acid molecule” and have canceled claims 8 and 30. Applicants have thereby obviated the 35 U.S.C. §112, first paragraph rejection of claims 8, 10, 28, 30, 33, 34 and 47. Therefore, Applicants respectfully request reconsideration and withdrawal of the foregoing 35 U.S.C. §112, first paragraph rejection.

The Rejection of Claims 8-10, 24-26, 28-30, 33-36, 38-41 and 47 under 35 U.S.C. §112,

Second Paragraph, Should Be Withdrawn

Claims 8-10, 24-26, 28-30, 33-36, 38-41 and 47 are rejected under 35 U.S.C. §112, second paragraph, “[a]s being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.” Specifically, the Examiner states that “[i]t is unclear whether TANGO294 may also possess those activities; and the metes and bounds of the claims cannot be determined.” The Examiner thus suggests the use of the term “lipase activity” rather than “TANGO294 activity”. In the interest of expediting prosecution, and without acquiescing to the Examiner's rejection, Applicants have adopted the Examiner's suggestion and have used the term “lipase activity” in the new claims, thereby obviating the 35 U.S.C. §112, second paragraph rejection of claims 8-10, 24-26, 28-30, 33-36, 38-41 and 47.

The Rejection of Claims 8, 24-26, 29, 42, 43 and 45 under 35 U.S.C. §112,

First Paragraph, Should Be Withdrawn

Claims 8, 24-26, 29, 42, 43 and 45 are rejected under 35 U.S.C. §112, first paragraph, “[a]s the specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims.” The Examiner asserts that:

[t]he issue is not whether generating functional variants or fragments or lipase activity assays are routine in the art, nor whether the present TANGO294 contains a lipase serine active site. Rather, the issue is that the present TANGO294 is an enzyme (a lipase), and has 390 amino acids in its mature form, and that the art has not established nor reasonably predicted that a small fragment such as 40 amino acids of an enzyme molecule of 390 amino acids would retain the desired enzymatic activity even if such a small fragment is from the region contains a lipase serine active site.

In the interest of expediting prosecution, and without acquiescing to the Examiner's rejection, Applicants have removed any fragment language from the newly written claims and have canceled claims 24-26, 29, 42, 43 and 45, thereby obviating the 35 U.S.C. §112, first paragraph rejection of claims 8, 24-26, 29, 42, 43 and 45. Therefore, Applicants respectfully request reconsideration and withdrawal of the foregoing 35 U.S.C. §112, first paragraph rejection.

The Rejection of Claims 28, 33, 38, 46 and 47 under 35 U.S.C. §112,

First Paragraph, Should Be Withdrawn

Claims 28, 33, 38, 46 and 47 are rejected under 35 U.S.C. §112, first paragraph, “[a]s containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention.” The Examiner asserts that:

[w]hile digestion of fats requires a lipase, transport and absorption of a lipid is not known to be functional activities of a lipase. By digesting fats and breaking down fats into their component parts, a lipase facilitates transport and absorption, but not modulate transport and absorption of a lipid, as the art has not established a direct role of a lipase in transport and absorption of a lipid, not that determining lipase activity of a protein is tantamount to determining the absorption of transport activity of the same.

In the interest of expediting prosecution, and without acquiescing to the Examiner's rejection, Applicants have canceled claims 28, 33, 38, 46 and 47, thereby obviating the 35 U.S.C. §112, first paragraph rejection of claims 28, 33, 38, 46 and 47. Therefore, Applicants respectfully request reconsideration and withdrawal of the foregoing 35 U.S.C. §112, first paragraph rejection.

The Rejection of Claim 8 under 35 U.S.C. §112,

First Paragraph, Should Be Withdrawn

Claim 8 is rejected under 35 U.S.C. §112, first paragraph, “[a]s containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.” Specifically, the Examiner states that “[t]he specification fails to provide the deposit statement indicating the deposit material will be readily available to the public without restriction upon issuance of the patent.” Applicants submit herewith a signed deposit statement, as requested by the Examiner. Therefore, Applicants respectfully request reconsideration and withdrawal of the foregoing 35 U.S.C. §112, first paragraph rejection.

CONCLUSIONS

In view of the amendments and remarks made herein, Applicants respectfully submit that the objections and rejections presented by the Examiner are now overcome and that this application is now in condition for allowance. Early notice to this effect is solicited.

If in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned.

It is believed that this paper is being filed timely and that a two month extension of time is required. In the event any additional extensions of time are necessary, the undersigned hereby authorizes the requisite fees to be charged to Deposit Account No. 501668.

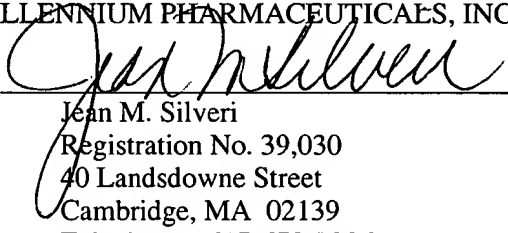
Entry of the remarks made herein is respectfully requested.

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Respectfully submitted,

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